

REMARKS

Claims:

Claims 1-19 and 28-35 are pending in the instant application. Claims 1, 10 and 12 are amended for clarity; claim 19 is amended to correct antecedence. Claim 19 now properly depends from claim 12. Claims 28-35 are newly added.

Drawings:

The drawings are amended for clarity of illustration, and the specification is amended to reflect the changes to the drawings. Specifically, reference numbers have been added to show front and rear faces of the tape body, in FIG. 5. Support for this amendment, the accompanying amendment to the specification and new claims 28-35 may be found in the application as filed, including the claims. No new matter is added with new claims 28-35 or with the amendments to the specification, claims or drawings.

It is respectfully submitted that amendments and remarks presented herein address each of the points made in the Office Action mailed 14 March 2005.

1. Claim Rejections – 35 U.S.C. §102 (Townend)

Claims 1-5, 7-8, 11-14, 16-17 and 19 stand rejected under 35 U.S.C. §102(b) as being anticipated by International Application Publication No. WO 02/38870 A1 (hereinafter, "Townend"). Applicant respectfully disagrees and traverses the rejection.

To anticipate a claim, Townend must teach every element of the claim and "the identical invention must be shown in as complete detail as contained in the ... claim." *MPEP 2131* citing *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987) and *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989). Townend does not teach every element of Applicant's claims, as demonstrated herein below.

Claims 1 and 12: The Examiner states that Townend "relates to a pavement tape (10) for conveying information (printed matter) when affixed to a pavement (11)." Respectfully, we disagree. Townend describes a flexible **display panel** (10), not a tape. A panel and a tape are different structures. For example, the American Heritage® Dictionary differentiates "tape" and "panel" as follows:

Tape: A continuous narrow, flexible strip of cloth, metal, paper, or plastic, such as adhesive tape, magnetic tape, or ticker tape. (*The American Heritage® Dictionary of the English Language, Fourth Edition*, © 2000 by Houghton Mifflin Company.)

Panel: A flat, usually rectangular piece forming a raised, recessed, or framed part of the surface in which it is set. (*The American Heritage® Dictionary of the English Language, Fourth Edition*, © 2000 by Houghton Mifflin Company.)

As noted above, tape is by nature "continuous". A panel is not. However, for clarity, Applicant has amended independent claims 1 and 12 to recite "a continuous elongated flexible tape body...wherein front and rear faces do not overlap an end of the pavement tape." Support for the amendments to claims 1 and 12 may be found throughout the specification; for example, a continuous tape is described in the description of FIGs. 1, 3 and 3A(see p. 5, ¶ [0043]; p. 6, ¶ [0050], and p. 7, ¶ [0053]). Further, FIGs. 5, 6 and 15 show end views of the pavement tape. As illustrated, the front and rear faces do not overlap the end of the pavement tape. Amended claim 5 is particularly helpful in pointing out this feature.

Townend does not teach a continuous tape body, as in amended claims 1 and 12. Neither does Townend teach a tape body where front and rear faces do not overlap an end of the tape body. Rather, Townend illustrates and recites a display panel enveloped in a protective layer. For example, Townend recites: "A transparent wear and weather resistant top coating layer (14) is applied to the upper surface of the backing layer (12) and also overlies and protects the printed image (15) *while at the same time linking with the foundation layer (13) carried, or actually incorporated into the surface of the backing layer (12)*" (p. 6, lines 4-9, emphasis added). As shown in the Figure, top coating layer 14 overlaps the fibrous backing layer 12 in order to link with underlying foundation layer 13. Townend's panel is therefore neither continuous, nor free at its ends in the manner of Applicant's tape. For example, a cross-section taken from the center of Townend's basic panel differs from the end of the panel. According to Townend's figure and description, the end of the panel includes top coating layer 14 both on its top and (at least partially) over its side, whereas a cross section of the panel would include layer 14 *only* at its top.

On the other hand, a cross-section taken from the basic tape of Applicant's claim 1 or claim 12 would substantially match the end of said tape (see FIGs. 1, 2, and 6-13).

Applicant has demonstrated that amended claims 1 and 12 are patentable over Townend, at least because Townend does not teach or suggest (a) a tape, let alone a continuous tape, or (b) a structure where front and rear faces do not overlap an end. Claims 2-5, 7-8, 11-14, 16-17 and 19 depend from either claim 1 or claim 12, and thus benefit from like argument. However, there are additional patentable distinctions between the cited reference and claims 2-5, 7-8, 11-14, 16-17 and 19, including the following:

Claims 3 & 14: Townend does not teach a flexible release tape releasably bonded to an adhesive on a rear face of a pavement tape. Townend suggests that "it may be desirable to apply a primer to the support surface and/or to the underside of the foundation layer, to improve adhesion" (p. 4, lines 25-27). However, a primer is not the same thing as a tape, and primers are permanent, not releasably bonded to the surface upon which they are applied.

Claims 4 & 13: Townend does not teach or suggest a flexible protective tape releasably bonded to a front face of a pavement tape. Rather, as noted above, Townend recites a top coating layer 14 that links with a foundation layer (see above). There is no indication within Townend that top coating layer 14 is in any way releasable.

Claims 8 & 17: Townend does not teach or suggest a front face with any reflective quality, as in claim 8. For example, as noted by the Examiner, a part of Townend's panel can be reflective "because of the presence of glass beads, silica beads, or opalescent sand *in the protective layer*" (p. 2, last paragraph, emphasis added). As shown and described, Townend's fibrous backing layer 12, which the Examiner likens to an elongated flexible tape body with printed matter on its front surface, is a separate component from protective layer (14). Townend thus teaches a reflective *overlay* atop printed material on a front surface. This differs from an at least partially reflective *front face*, as in claim 8.

Claims 11 & 19: Townend does not teach at least one protective railing, as in claims 11 and 19. The Examiner points to the drawing, stating that the protective layer has railings that extend downward along the side to protect the edges of the tape. Respectfully, we disagree. Townend nowhere teaches or suggests railings. The downward extensions, as noted by the Examiner (see p. 2, last paragraph), are extensions of protective layer (14) that link with the foundation layer.

A protective layer is not a railing. For example, as supported by the specification, Applicant's railings "provide a protective *recess* for pavement tape 100 from weather or traffic damage"(p. 12 ¶ [0078]). Townend's protective layer (14) provides no such recess.

Applicant has demonstrated patentability of claims 1-5, 7-8, 11-14, 16-17 and 19 over Townend. Withdrawal of the Examiner's rejection, and allowance of claims 1-5, 7-8, 11-14, 16-17 and 19, are respectfully requested.

2. Claim Rejections – 35 U.S.C. §102 (Wilson)

Claims 1-3, 5, 9, 12, 14 and 18 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,795,637 (hereinafter, "Wilson). Respectfully, Applicant disagrees and traverses the rejection, as Wilson does not anticipate the claims. For example, as shown below, Wilson does not teach every element of the claim, nor does Wilson show the identical invention, in as complete detail as contained in the claims.

Claims 1 & 12: Amended claims 1 and 12 both recite a pavement tape including a continuous, elongated flexible tape body, with front and rear faces that do not overlap an end of the tape body. Wilson does not teach or suggest a pavement tape, but rather teaches "a device and method for use in protecting uncured seam sealers from debris contamination and foot traffic immediately following a resilient *vinyl floor* covering installation" (col. 4, lines 27-9, emphasis added). Wilson's device differs from Applicant's pavement tape not only in purpose, but also in at least composition and shape.

For example, Wilson does not disclose a pavement tape, and there is absolutely no teaching or suggestion within Wilson that his device could be used as such. Indeed, logically, Wilson's device could not be used for such a purpose without being destroyed. Foot or motor traffic upon Wilson's device would crush the cardboard tent.

In contrast, Applicant's pavement tape is intended for use in such conditions; indeed, the tape body may even include "an abrasive...to enhance traction for pedestrians as well as motorists" (p. 8 [0057]).

Furthermore, Wilson's seam sealer protector differs from Applicant's pavement tape in composition. For example, as described in the Specification, an embodiment of Applicant's pavement tape may be "made from plastic based on an acrylic resin...sheet or bar stock [or] other plastics, fabrics and woven metal screens" (p 5, [0044]). There is no indication that Wilson's device may be similarly constructed—it is shown and described as a cardboard blank that may be folded to form a tent structure, with strips of adhesive tape (14, 16) on the bottom of cardboard tabs (2, 4) on each side of the blank (see FIGs. 1-4).

Wilson's device also differs from Applicant's pavement tape in construction and shape. For example, Wilson's device is described and shown as tent-shaped (see FIG. 4) with a central cavity positioned over a line of seam sealer. As supported by the Specification and Drawings, Applicant's pavement tape may be embodied as a continuously flat-bottomed tape, without a central cavity (see for example FIGs. 2, 5 and 6). If Wilson's device were a continuous, flat-bottomed structure, it could touch the seam sealer, and therefore contaminate it. Wilson teaches strongly against anything touching seam sealer, for example faulting prior art seam protectors because "a gust of wind or accidental bump may shift the tent and cause the seam sealer to smear as well as become contaminated" (col. 3, lines 6-8). If Wilson's device were flat-bottomed, it might also stick to the seam sealer, seam sealer being "sticky until fully cured: a process that requires from one to eight hours" (col. 2, lines 8-9).

In addition, Wilson also fails to teach a continuous elongated tape body with a front face comprising or bearing at least one symbol. Wilson specifies that printed matter (e.g., symbol) is printed on sub-center panels 8 and 10 of the cardboard blank, *not* on any tape body. For example, Wilson recites "One could print "Caution: Electrical Wires" on both sub-center panels" (col. 8, lines 63-64), and "in the preferred embodiment, markings such as those printed on a yardstick, or meterstick, including increments, will be printed along the upper surface of each sub-center panel of the blank" (col. 8, lines 44-47). As shown in FIGs. 1 and 4 and recited in the description thereof, sub-center panels 8 and 10 are features of the cardboard blank, not features of a tape body.

Applicant has shown that multiple features of claims 1 and 12 are not taught by Wilson. Wilson additionally fails to teach "a rear face comprising an adhesive for bonding said pavement tape to pavement", as in claim 12. First, there is no indication

that Wilson's device could be bonded to pavement. For example, Applicant's pavement tape, as supported by the specification, may be "coated with a strong, active adhesive" (p. 11, [0070]). Wilson's device is intended for use on a vinyl floor, and meant to be "simple for a unskilled person to remove and discard in a common household waste receptacle" (col. 4, lines 46-48).

As noted above, Applicant's tape body is flat-bottomed, without any central cavity. The rear face of the tape body is also flat (see for example FIGs. 1-6), such that the entire tape body may adhere to pavement. Wilson teaches only adhesive portions of a tented cardboard blank. Even if Wilson's device were flattened to eliminate the cavity between the floor and the cardboard tent (which, as noted, would run counter to its intended purpose), it would not teach the adhesive rear face of claim 12. Wilson's flattened device would still consist of a cardboard blank with adhesive disposed only under tabs 2 and 4.

Applicant has demonstrated that Wilson does not teach each and every limitation of claims 1 and 12. Claims 5, 9, 12, 14 and 18 depend from either claim 1 or claim 12, and benefit from like argument. Additional patentable distinctions of claims 5, 9, 12, 14 and 18 include the following:

Claim 5: Wilson does not teach a pavement tape with at least one symbol conveying commercial information. Wilson teaches only the "Caution" and "yardstick" markings noted herein above, not commercial information such as directions to a hotel (see [p.11 [0072]]) or "commercial information for the general direction, by opposite arrows, of "XYZ DRUG" and "ACME GAS"" (p. 12 [0076])

Claim 9: Contrary to the Examiner's assertion, Wilson in fact does not teach a symbol formed as a perforation extending at least partly from a front face to a rear face of a tape body. The Examiner points to Fig. 1 of Wilson, stating "Wilson relates to a flooring seam cover tape having perforated lines (3, 5, 7) with adhesive (14, 16) on the rear surface thereof...The perforations extends [sic] from the front top face to the rear face of the tape (figures 3 and 4)" (p. 3, second paragraph).

Perforated lines (3, 5, 7) are in a "rectangular corrugated cardboard blank...The blank has first and second slit score lines 3 and 5 extending lengthwise along the lower surface near first and second edges 17 and 19, respectively...The blank has a third regular score line 7 extending lengthwise along the lower surface of

the blank" (col. 5 lines 36-46). These perforations are presumably designed to facilitate folding the blank into "its useful form as tent like cover 30" (col. 7, line 21). Wilson specifies that the perforations are "Just inside the tape line, and also...bisecting the length of the blank, and also...bisecting the width of the blank at select intervals" (col. 4, lines 57-59). Perforated lines in a blank are different from Applicant's perforated symbols in a tape body.

Claim 14: Claim 14 depends from claim 13, and thus inherits the limitation of a flexible protective tape releasably bonded to the front face of a pavement tape. Claim 14 further recites a flexible release tape, releasably bonded to the adhesive of claim 12. As noted, Wilson does not teach an adhesive for bonding to pavement (claim 12). Furthermore, Wilson does not teach a protective tape releasably bound to the front face of his device (claim 13). Finally, Wilson does not teach a release tape releasably bound to an adhesive, instead teaching "adhesive tape 14 and 16 *permanently* attached to the lower surfaces of tabs 2 and 4, and covered by strips of *removable paper film* 18 and 20, respectively" (col. 6, lines 19-22, emphasis added).

Claim 18: Wilson also fails to teach a symbol formed as a perforation extending at least partly from a front to a rear face of a tape body. As noted with respect to claim 9, the perforations described in Wilson are located in a cardboard blank.

As demonstrated, Wilson fails to teach or suggest each limitation of claims 1-3, 5, 9, 12, 14 and 18. Applicant thus requests withdrawal of the Examiner's rejection, and allowance of the claims.

Claim Rejections – 35 U.S.C. §103

Claims 6 and 15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Townend. Respectfully, we disagree and traverse the rejection, since Townend does not render claims 6 and 15 *prima facie* obvious. The following is a quotation from the MPEP setting forth the three basic criteria that must be met to establish a *prima facie* case of obviousness:

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings.

Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” MPEP, §2142, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claims 6: Claim 6 depends from claim 1. As demonstrated, Townend does not teach all of the limitations of claim 1. Neither does Townend suggest all of the limitations of claim 1. For example, Townend does not suggest a pavement tape with a continuous elongated tape body. Indeed, Townend's drawing teaches away from a continuous structure. Claim 6 is thus believed allowable at least because Townend fails to establish a *prima facie* case of obviousness over base claim 1.

Claim 15: Claim 15 depends from claim 12, and also benefits from the limitations of intervening claims 14 and 13. Townend does not teach all of the limitations of claim 12, 13 or 14, as demonstrated above. Neither does Townend suggest such limitations. Townend fails to establish a *prima facie* case of obviousness over claims 12, 13 and 14, and thus also fails to establish a *prima facie* case of obviousness over claim 15.

New Claims

The arguments presented herein above also apply to new claims 28-35.

Allowable Subject Matter

The Examiner objected to claim 10 as being dependent upon a rejected base claim, but indicated that claim 10 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant thanks the Examiner for the indication of allowable subject matter, and agrees that the prior art fails to teach the presence of a flexible mask tape having at least one symbol formed as a perforation extending from its front face to its rear face, the tape bonded to the front face of the pavement tape. However, Applicant believes that the other claims are shown to be allowable over the cited references.

CONCLUSION

Applicant has demonstrated that the cited prior art does not teach or suggest each limitation of claims 1-19 and 28-35. The references thus fail under 35 U.S.C. §§102-103. Applicant respectfully requests withdrawal of each of the Examiner's

rejections and objections, and solicits a Notice of Allowance for all of claims 1-19 and 28-35.

28 claims, including three independent and 25 dependent claims, remain pending in the instant application. This is equal to the number of independent and dependent claims originally paid for; therefore, no fees are believed due for newly added claims 28-35. However, if any fee is deemed necessary in connection with this Amendment and Response, the Commissioner is hereby authorized to charge Deposit Account No. 12-0600.

We specifically request to interview this case should any issues remain outstanding; the Examiner is therefore encouraged to telephone the undersigned attorney should this occur and prior to any further rejection.

Respectfully submitted,

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IN THE DRAWINGS

Figure 5 is amended to add reference numbers showing front and rear faces of tape body 101. No new matter is added.

**ATTACHMENT: ONE (1) REPLACEMENT SHEET INCLUDING AMENDED
FIGURE 5.**